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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/821,783

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Rupert Vielhaber

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7590

12/16/2005

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EXAMINER

TA, THO DAC


ART UNIT

PAPER NUMBER

2833

DATE MAILED: 12/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/821,783	Applicant(s) VIELHABER ET AL. 	
	Examiner Tho D. Ta	Art Unit 2833	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☒ Claim(s) 10 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/20/04</u> . | 6) <input type="checkbox"/> Other: ____  |

## DETAILED ACTION

### *Claim Objections*

1. Claim 8 is objected to because of the following informalities: claim 8, line 3, the limitation "a cable connector" has not been disclosed in the specification. Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1 and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Endo et al. (6,607,399).

In regard to claim 1, Endo et al. discloses a coupler for a coaxial plug connectable with a cable comprising: an outer conductive sleeve 2 of metal, an insulator 4 within the sleeve 2 and a contact element 3 within the insulator 4, the sleeve 2, the insulator 4 and the contact element 3 being coaxial with one another, the sleeve 2 being composed of a plastically deformable sheet metal blank whose shape is formed by stamping (column 5, lines 16-19) and whose sleeve shape is produced by bending of the blank.

In regard to the language “capable of being used as an antenna coupler”, it has been held that the recitation that an element is “capable of” performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138.

In regard to claim 9, Endo et al. discloses that the outer conductive sleeve 2 is rolled (i.e. surrounding) onto the insulator 4.

4. Claims 1-3 are rejected under 35 U.S.C. 102(e) as being anticipated by Fukamachi et al. (6,746,267).

In regard to claim 1, Fukamachi et al. discloses a coupler for a coaxial plug connectable with a cable comprising: an outer conductive sleeve 25 of metal, an insulator 23 within the sleeve 34 and a contact element 21 within the insulator 23, the sleeve 25, the insulator 23 and the contact element 21 being coaxial with one another. It is noted that the claim describes a process of manufacturing (i.e. the sleeve being composed of a plastically deformable sheet metal blank whose shape is formed by stamping and whose sleeve shape is produced by bending of the blank) which is incidental to the claim apparatus. It is well established that a claimed apparatus cannot be distinguished over the prior art by a process limitation. Consequently, absent a showing of a structural difference between the claim product and the prior art, the subject by process claim limitation is afforded little patentable weight (see MPEP 2113).

In regard to the language “capable of being used as an antenna coupler”, it has been held that the recitation that an element is “capable of” performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138.

In regard to claim 2, Fukamachi et al. discloses that at one end of the plug receiving region of the outer conducted sleeve 25 being surrounded by a spring ring 28.

In regard to claim 3, Fukamachi et al. discloses that the ring 28 is received between formations of the outer conductive sleeve 25 on opposite sides of the spring ring 28.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 4-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Carter (3,923,367).

In regard to claim 1, Carter discloses a coupler for a coaxial plug connectable with a cable comprising: an outer conductive sleeve 74 of metal, an insulator 76 within the sleeve 74 and a contact element 72 within the insulator 76, the sleeve 74, the insulator 76 and the contact element 72 being coaxial with one another. It is noted that

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plastically deformable sheet metal blank whose shape is formed by stamping and whose sleeve shape is produced by bending of the blank) which is incidental to the claim apparatus. It is well established that a claimed apparatus cannot be distinguished over the prior art by a process limitation. Consequently, absent a showing of a structural difference between the claim product and the prior art, the subject by process claim limitation is afforded little patentable weight (see MPEP 2113).

In regard to the language “capable of being used as an antenna coupler”, it has been held that the recitation that an element is “capable of” performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138.

In regard to claim 4, Carter discloses that the insulator 76 is formed with at least one circumferential outer ring 111.

In regard to claim 5, Carter discloses that the outer conductive sleeve 74 has at least one bulge shaped enlargement being and receiving the ring 111 (see fig. 2).

Please note that the method of forming a device is not germane to the issue of patentability of the device itself. Therefore, the limitation “formed by upsetting, rolling” has been given little patentable weight. Please note that the claim does not present any structural difference from the prior art.

In regard to claim 6, Carter discloses that the insulator 76 has at least one further ring (at 98 in fig. 2) spaced from the first mentioned ring 111 and dimensioned to enable the insulator 76 to be fitted axially into the outer conductive sleeve 74.

In regard to claim 7, Carter discloses that the outer conductive sleeve 74 has at least two bulge shaped enlargements (at 98 and 111) with a constricted region 102 between them.

In regard to claim 8, Carter discloses that the outer conductive sleeve 74 has a third bulge shaped enlargement (at 104) between another of the bulge shaped enlargements and a cable connector 118 on the outer conductive sleeve 74.

7. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Karlovich (5,037,328).

In regard to claim 1, Karlovich discloses a coupler for a coaxial plug connectable with a cable comprising: an outer conductive sleeve 30 of metal, an insulator 26 within the sleeve 30 and a contact element 40 within the insulator 26, the sleeve 30, the insulator 26 and the contact element 40 being coaxial with one another. It is noted that the claim describes a process of manufacturing (i.e. the sleeve being composed of a plastically deformable sheet metal blank whose shape is formed by stamping and whose sleeve shape is produced by bending of the blank) which is incidental to the claim apparatus. It is well established that a claimed apparatus cannot be distinguished

over the prior art by a process limitation. Consequently, absent a showing of a structural difference between the claim product and the prior art, the subject by process claim limitation is afforded little patentable weight (see MPEP 2113).

In regard to the language "capable of being used as an antenna coupler", it has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138.

#### ***Allowable Subject Matter***

8. Claim 10 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. The following is a statement of reasons for the indication of allowable subject matter: the prior art fails to provide teach or suggest the combination of a prelocking element engaged usually upon insertion of the outer conductive sleeve in the support body and a locking slider engageable with at least one bulge like enlargement in the outer conductive sleeve for retaining the outer conductive sleeve in the support body.

#### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tho D. Ta whose telephone number is (571) 272-2014. The examiner can normally be reached on M-F (8:00-5:30).



If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula A. Bradley can be reached on (571) 272-2800 ext 33. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



THO D. TA  
PRIMARY EXAMINER